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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/852,119	05/06/97	JONES M	507011026

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EXAMINER	
LOUIS JACQUES,J	
ART UNIT	**PAPER NUMBER**
3661	17

DATE MAILED: 04/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action	Application No. 08/852,119	Applicant(s) JONES, MARTIN	
	Examiner Jacques H. Louis-Jacques	Art Unit 3661	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED *12 April 1999* FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either a timely filed amendment which places the application in condition for allowance or a Notice of Appeal. Alternatively, applicant may obtain further examination by timely filing a request for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d).

PERIOD FOR REPLY

a) ☐ The period for reply continues to run from _____, the mailing date of the final rejection.

b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from _ the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136 (a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked.

1.☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for reply set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

2.☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.

3.☒ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);

(b) ☐ they raise the issue of new matter. (see Note below);

(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

4.☐ Applicant's reply has overcome the following rejection(s): _____.

5.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

6.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

7.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

8.☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *1-21 and 23-49*.

Claim(s) withdrawn from consideration: _____.

9. ☐ The proposed drawing correction filed on _____ a)☐has b)☐ has not been approved by the Examiner.

10.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

11.☐ Other:

Jacques Louis-Jacques
JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER

Continuation of 6. does NOT place the application in condition for allowance because:
While it is admitted that the the Ross patents 5,444,444 and 5,648,770, having publication dates of August 22, 1995 and July 15, 1997, respectively cannot be used in 35 USC 102(b) rejections, the two patents have an effective US filing date of March 14, 1993 which is earlier that the US effective filing date of the present application which is May 18, 1993.
It is further noted that applicant relied on Applied Materials Inc. v. Gemini Research Corp., 15 U.S.P.Q.2d 1816, 1818 (Fed. Circ.) to state that "the fact that an application named a different inventive entity that a patent does not necessarily make that patent prior art." However, the present applicant names only one inventor Mr. Martin Kelly Jones, while the US patents in question name only one and distinct inventor Mr. John Ross.
Further it is noted that applicant relied in the case of In re Mathews to show that the Ross derived his knowledge from applicant. However, one major difference between the present applicant and the In re Mathews' case is that Dewey and Mathews were co-workers. In the present case, there is no showing (other than applicant's statement) that applicant and Ross were co-workers. In fact, let it be known that the US patents to Ross, which named only one inventor, Mr. John Ross, are assigned to Worldwide Notification Systems, Inc. and the present applincation, which names only one inventor, Mr. Martin Kelly Jones, is assigned to Global Research systems, Inc. Therefore, although the patents to Ross are not prior art under 102(b), their effective US filing dates are before the effective US filing of the present application, thereby qualifying them as prior art under 102(e).
The mere fact that the declaration filed on February 8, 1999 includes a statement, by applicant, that applicant is a "co-inventor" of the patents to Ross and that applicant invented the subjet matter disclosed in the patents to Ross, is not a basis to remove the Ross patents as prior art and withdrawn the rejections.
Based on the limited information presented herein, the examiner is not able to make a decision as to withdrawn the rejections. Applicant would need a disclaimer from Mr. Ross and/or the assignee of the Ross patents affirming that applicant's statement is true or any other evidence showing such. If Mr Ross refuses to coorporate, this issue is out of the examiner's hand and should be resolved between applicant and Mr. John Ross.

JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER